



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------|-------------|----------------------|---------------------|------------------|
| 10/549,978 | 11/15/2006 | Martin Pruschy | 4-32911A | 3436 |
| 1095 7550 10/15/2009 | | | | |
| NOVARTIS | | | | |
| CORPORATE INTELLECTUAL PROPERTY | | | | |
| ONE HEALTH PLAZA 104/3 | | | | |
| EAST HANOVER, NJ 07936-1080 | | | | |
| EXAMINER | | | | |
| GEMBEH, SHIRLEY V | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1618 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 10/15/2009 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/549,978

Applicant(s)

PRUSCHY, MARTIN

Examiner

SHIRLEY V. GEMBEH

Art Unit

1618

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 September 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
b) ☐ They raise the issue of new matter (see NOTE below);
c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
NOTE: See *Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-5 and 10.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached *Information Disclosure Statement(s)*. (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/S. V. G./
Examiner, Art Unit 1618

/Robert C. Hayes, Ph.D./
Primary Examiner, Art Unit 1649

Continuation of 3. NOTE: The newly added claim 11 not previously submitted for examination will require further search and/or consideration.

Continuation of 11. does NOT place the application in condition for allowance because: Claims 1-5 and 10 stand rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating a solid tumor such as prostate, glioma and thyroid tumors as specified in the specification (page 2) with ionizing radiation, does not reasonably provide enablement for treating a wide variation of solid tumors.

Applicant argues that newly added claim 11 limits the solid tumors to those specified on page 2 of the specification.

In response Applicant's arguments have already been addressed in the previous office actions, and are maintained for the reasons of record, or are directed to claim amendments not entered; thereby currently being moot.

Claims 1-5 stand rejected under 35 USC 102(e) as made of record in Paper No.20090616.

Applicant argues that Example 7 as indicated by the examiner shows the thiazole ring is substituted by hydroxymethyl and that the compounds of the instant claims specifically defined a methyl substitution.

In response, the Examiner erroneously typed example 7 whilst the actual citation should have been example 3. Regardless of the fact of the typographical error, the record clearly establishes that Vite et al. discloses epothilones A and B (see page 5 of response).

The assertion that there is no teaching in Vite that the compounds of Vite et al. would be preferred for the treatment of solid tumors is found not persuasive because Vite specifically teach that epothilones A and B compounds are used for treating solid tumors (see col. 5, lines 25-47). Also Vite specifically teach that these compounds may be combined with radiation (see col. 6, lines 18-20).